

Remarks

I. Status of the Claims

Claims 1-10, 12, 13, and 15-59 are pending in this application. Claims 57 and 58 were withdrawn from consideration by the Examiner. Claims 1, 55 and 56 were amended. These amendments raise no issue of new matter and Applicants respectfully request their entry.

Applicants thank the Examiner for indicating the allowable subject matter of claims 32-45. Applicants maintain that the remaining claims are patentable, however, and wish to continue prosecution of this application in view of the preceding amendments and following remarks.

II. Rejections under 35 U.S.C. § 112

A. Indefiniteness Rejection

The Examiner rejected claims 12 and 13 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Office Action at page 2. Specifically, the Examiner alleges that “the melting point” limitation lacks sufficient antecedent basis and invites Applicants to cancel claims 12 and 13. *Id.* at 2-3.

Applicants traverse this rejection. Applicants respectfully submit that the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. M.P.E.P. § 2173.05(e) at 2100-212. “If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” *Id.* (citing *Ex parte Porter*, 25 U.S.P.Q.2d 1144, 1145 (Bd. Pat. App. & Inter. 1992)). Here, melting point is an inherent element of the claimed cosmetic composition and “inherent

components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation 'the outer surface of said sphere' would not require an antecedent recitation that the sphere has an outer surface." *Id.* (citing *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 U.S.P.Q.2d 1216, 1218-19 (Fed. Cir 2001)).

Accordingly, for at least these reasons, Applicants request that this ground of rejection be withdrawn.

B. Enablement Rejection

The Examiner rejected claims 1-10, 12, 13, 15-18, 20-56 and 59 under 35 U.S.C. § 112, first paragraph, "because the specification, while being enabling for polycaprolactones as semi-crystalline thermal transition agents, does not reasonably provide enablement for any other semi-crystalline thermal transition agents having the claimed transition temperature and film resistance." Office Action at page 5.

Applicant's traverse this rejection. Applicant respectfully submit that an applicant's claim scope is not limited only to those embodiments actually disclosed in the specification. *See In re Strahilevitz*, 668 F.2d 1229, 212 U.S.P.Q. 561 (C.C.P.A.1982). Indeed, one can support broad claims without even a single disclosed embodiment. *See Spectra-Physics Inc. v. Coherent Inc.*, 827 F.2d 1524, 3 U.S.P.Q.2d 1737 (Fed. Cir. 1987); *see also Utter v. Hiraga*, 845 F.2d 993, 998 (A specification may, within the meaning of 35 U.S.C. § 112, first paragraph, contain a written description of a broadly claimed invention without describing all species that claim encompasses).

The Examiner contends that the specification does not provide any guidance as to how one skilled in the art would go about selecting other semi-crystalline thermal

transition agents. However, “[n]ot everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. All that is necessary is that one skilled in the art be able to practice the invention given the knowledge and skill in the art.” M.P.E.P. § 2164.08 at 2100-197.

In the present case, Applicants submit, one skilled in the art would be able to determine whether a semi-crystalline compound has the claimed transition temperature range and water solubility, as these properties are widely known to the skilled artisan.

To meet the requirements of § 112, first paragraph, Applicants submit that one skilled in that art need only know how to select or identify, without undue experimentation, at least one thermal transition agent chosen from semi-crystalline compounds having the claim limitations. Again this selection would be based on the routine determination of readily measurable properties, such as transition temperature and water solubility. Routine experimentation does not constitute undue experimentation. *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1360 (Fed. Cir. 1998).

The Examiner also argues that because the “specification does not provide any guidance as to how one skilled in the art would go about selecting other semi-crystalline thermal transition agents that have the required transition temperature and hot water solubility,” one skilled in that art would not be able to identify which thermal transition agents fall within the scope of the claims without undue experimentation. Office Action at page 9. The specification, however, need not disclose what is well-known to those skilled in that art and preferably omits that which is well-known to those skilled and already available to the public. M.P.E.P. § 2164.05(a). Here, Applicants submit that

one skilled in the art would be able to identify which thermal transition agents fall within the scope of the claims by routine experimentation.

Finally, the Examiner contends that the “specification does not provide any working examples that exemplify semi-crystalline thermal transition agents other than polycaprolactones.” Office Action at page 10. Working examples, however, are not required for a specification to be enabling. See e.g., *In re Wright*, 999 F.2d 1557, 1561 (C.C.P.A. 1977) (“Nothing more than objective enablement is required, and therefore it is irrelevant whether [a] teaching is provided through broad terminology or illustrative examples.”); *In re Robins*, 429 F.2d 452, 457 (C.C.P.A. 1970) (stating that “representative [samples] are not required by the statute and are not an end in themselves”).

As explained above, however, Applicants submit that one skilled in the art could make and use the claimed at least one thermal transition agent chosen from semi-crystalline compounds other than polycaprolactones because the determination of such materials would involve only routine experimentation, which is not undue experimentation. *CellPro*, 152 F.3d at 1360.

Accordingly, for at least these reasons, Applicants request that this ground of rejection be withdrawn.

III. Rejection Under 35 U.S.C. § 102

The Examiner has rejected claims 1-10, 15-31, and 46-56 under 35 U.S.C. § 102(b) as being anticipated by Hoefer et al. (U.S. Patent No. 5,312,865) (“Hoefer”) for the reasons disclosed on page 3 of the Office Action. The Examiner states that Hoefer teaches a composition for coating leather containing “an aqueous dispersion of

polyurethane particles” wherein the polyurethane is “prepared from a mixture of polycaprolactone diols having OH value of 15 to 1540 and a molecular weight of 230 to 10,000.” Office Action at page 3. The Examiner then alleges that “[t]he recitation of transition temperature, water solubility and film resistance in the instant claims is inherent in the reference because the reference teach[es] the same polymers used in the same concentration as disclosed and claimed herein.”

This rejection is improper because the Examiner has not shown that the compositions of Hoefer necessarily and inevitably possesses all of the claim limitations. As stressed by Applicants in the responses filed January 10, 2003 and April 2, 2004, Applicants reiterate that inherent anticipation arises only when “the prior art necessarily functions in accordance with, or includes, the claimed limitations.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999) (emphasis added). Inherency may not be established by probabilities or possibilities. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991).

In the present case, the Examiner asserted that the claimed properties, such as water solubility, are “inherent in the reference.” Office Action at page 3. Applicants disagree, and submit that Hoefer actually teaches away from this alleged inherent property. Specifically, Applicants submit that the nature of the Hoefer invention, a coating composition, would suggest that the composition taught therein would not have hot water resistance limitations (i.e. the composition being able to be removed with hot water) of the claimed invention. Indeed, the Hoefer specification touts the “particularly high fastness values” of its coating composition. Hoefer, col. 6, lines 25-33.

Moreover, the claims of the present invention, as amended, are directed towards “a cosmetic composition for a keratinous material,” a mascara, and a “cosmetic care or make-up process.” Hoefer is not directed to such cosmetic uses; rather, Hoefer is directed to the production of coatings on flexible substrates, such as leather, leather substitutes, and flexible plastics. Hoefer, col. 6, lines 65-69. Indeed, it is not clear that a composition for coating leather will necessarily be able to function as a mascara, a cosmetic composition for a keratinous material, or in a cosmetic care or make-up process.

For at least these reasons, Applicants respectfully submit that the standard for anticipation has not been met. Accordingly, Applicants request that this ground for rejection be withdrawn.

IV. Rejections under 35 U.S.C. § 103

The Examiner has rejected claim 59 under 35 U.S.C. § 103(a) as being unpatentable over Hoefer. Office Action at page 4. Applicants traverse this rejection and respectfully submit that the Examiner has not made a prima facie case for obviousness.

An Examiner bears the initial burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). M.P.E.P. § 2142. To establish a prima facie case of obviousness the Examiner must demonstrate, for example, that (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, and (2) the prior art reference or references

teach all the claim limitations. *Id.* Here, the Examiner has not established either requirement.

As explained above, the Examiner has not shown that Hoefer teaches all the limitations of the claimed invention. See discussion at section III. Moreover, the Examiner concedes that Hoefer does “not explicitly teach [the] emulsifiers of [claim 59]. Office Action at page 4.

Additionally, the Examiner has not shown, nor does Hoefer contain, the motivation to modify the reference. The Examiner argues that “in order to incorporate waxes in aqueous emulsions, one of ordinary skill in the art would have been motivated to employ emulsifiers.” Office Action at page 4. This argument presupposes that one would be motivated to incorporate waxes into the claimed invention, but the Examiner has not provided a reason why one skilled in the art would be motivated to do so.

With regard to the claimed emulsifier concentration of claim 59, the Examiner contends that the determination of optimal or workable concentration of the emulsifier by routine experimentation is obvious absent showing of criticality of the claimed concentration. According to the Examiner, one having ordinary skill in the art would have been motivated to do this to obtain the desired coating and film-forming properties of the composition. *Id.* This argument must fail because the “coating and film-forming properties,” which Applicants assume to be the transition temperature and hot water/cold water resistance properties are not taught by Hoefer, as explained above in section III, and thus, one skilled in the art would not be motivated to optimize those properties to arrive at the claimed concentration.

For at least these reasons, Applicants respectfully submit that Hoefer does not establish a prima facie case of obviousness. Accordingly, for at least these reasons, Applicants request that this ground for rejection be withdrawn.

VI. Conclusion

In view of the foregoing amendment and remarks, Applicants respectfully request the reconsideration of this application, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON,
FARABOW, GARRETT & DUNNER, L.L.P.

Dated: October 8, 2004

By:



Debarshi Rahul Das
Reg. No. 55,100